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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,997	01/16/2004	Mark T. Marshall	P0020093.00/LG10126	8682
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MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER ALTER, ALYSSA MARGO	
			ART UNIT	PAPER NUMBER
			3762	
			NOTIFICATION DATE	DELIVERY MODE
			06/14/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.docketingus@medtronic.com  
sso@cardinal-ip.com

# Office Action Summary

**Application No.**

10/759,997

**Applicant(s)**

MARSHALL ET AL.

**Examiner**

Alyssa M. Alter

**Art Unit**

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-6 and 8-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 8-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 18, 2009 has been entered.

### ***Response to Arguments***

Applicant's arguments filed June 18, 2009 have been fully considered but they are not persuasive. The Applicant has amended the pending claims 1, 3-6 and 8-34 to include the limitation for the "elongated cable conductor comprising a plurality of inter-twisted wire strands". The Applicant claims this amendment is sufficient to overcome Halperin et al. (US 5,564,434 A), the prior art of record. However, Halperin et al. does in fact disclose an elongated cable conductor with a plurality of inter-twisted wire strands. The elongated cable conductor is depicted as coil 16 with multiple coiled strands as clearly displayed in figure 3. Therefore, the claims remain rejected under Halperin et al.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims are 1, 3-6 and 8-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification lacks support for the "inter-twisted" of wire strands within the cable conductor in combination with the other elements in the claim(s).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-6 and 8-34 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Halperin et al. (US 5,564,434 A) in view of Naylor et al. (US 5,491,299 A). Halperin et al. discloses a lead body with a sensor module as seen in figures 2 and 3. "The pressure sensor module 20 is located just proximal to the distal tip tine assembly 26 and is mechanically and electrically connected to the coaxial, outer and inner, coiled wire lead conductors 14 and 16"(col. 7, lines 20-24). The two wire lead conductors, 14 and 16, are separated by an inner insulating sleeve 46 and encased by an outer insulating sleeve 46. Since coil 16 is disposed within coil 14, the examiner considers conductor 14 to be the coil conductor

and coil 16 to be the cable conductor disposed within conductor 14. As seen in figure 3, the cable conductor is comprised of a plurality of coiled and thus wires twisted together to for the coil. Therefore, the examiner considers the coiled wires to be inter-twisted wires.

In the alternative, although the examiner considers the cable conductor of Halperin et al. to be inter-twisted, Halperin et al. discloses the device substantially as claimed except for the inter-twisted wire strands. Naylor et al. discloses in col. 5, lines 56-60, the inter-twisting of conductors to have a different lay (twist rate) so as to cancel the effects of the electromagnetic fields. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable coiling or twisting as depicted by Halperin et al. with the inter-twisting of Naylor et al. in order to provide the predictable results of reducing the electromagnetic fields of the conductor coils and thus preventing interference of the carried signals.

Additionally, the electrically insulative layer between the two conductors is the insulating sleeve 22. Furthermore, since the insulative sleeve covers the cable conductor (coil 16), the examiner considers it to be a coating over cable conductor.

In the alternative, although the examiner considers Halperin et al. or the modified Halperin et al. to disclose an insulative coating above, it would have been obvious at the time the invention was made to substitute the insulative sleeve over the cable conductor with an insulative coating on the exterior in order to yield the predictable results of insulating the conductor and reducing the diameter of the lead.

Furthermore, Halperin et al. discloses the use of polyurethane insulation, which has a dielectric coefficient or dielectric constant less than 10. Since the coil 14 and the coil 16 are formed from two separate components, there is necessarily a gap between the two, since they are not unitary.

Halperin et al. discloses the claimed invention except for the specific ranges of the size of the coil, insulation and the gap dimensions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the size of the coil, insulation and the gap dimensions, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (see MPEP 2144.05). Furthermore, determining the most appropriate size by routine experimentation would be prima facie obvious to one having ordinary skill in the art.

Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the size and dimension of the lead components as taught by Halperin et al. with a specific range since it was known in the art that modifications to the size and dimension of lead components to create a larger or more compact lead, the would modify the lead to meet specific patient needs.

As to claims 3, 8-14, 22-29, Halperin et al. discloses the claimed invention except for the preferred material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the the employed material as taught by Halperin et al. with the preferred material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

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suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (See MPEP 2144.07).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Alter whose telephone number is (571)272-4939. The examiner can normally be reached on M-F 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on (571) 272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/  
Primary Examiner, Art Unit 3762

/Alyssa M Alter/  
Examiner  
Art Unit 3762